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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/469,007 | 12/21/1999 | MARK H. LINEHAN | RSW9-99-080 | 4403 |

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| EXAMINER | |
| DEMICO, MATTHEW R | |
| ART UNIT | PAPER NUMBER |
| 2611 | |

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/469,007 | Applicant(s) LINEHAN, MARK H. | |
| | Examiner Matthew R Demicco | Art Unit 2611 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,7,8,20,26,27,39,45,46,59 and 62-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,7,8,20,26,27,39,45,46,59 and 62-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed 7/15/2004. Claims 1, 7-8, 20, 26-27, 39, 45-46, 59 and 62-71 are pending. Claims 1, 7-8, 20, 26-27, 39 and 45-46 are amended. Claims 62-71 are new. Claims 2-6, 9-19, 21-25, 28-38, 40-44, 47-58, 60-61 and 72-75 are canceled. Applicant states that Claims 28-39 are canceled but the Examiner believes that only 28-38 are canceled as Claim 39 is currently amended.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 7-8, 20, 26-27, 39, 45-46 and 59 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 7-8, 20, 26-27, 39, 45-46, 59, 64 and 69-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,878,141 to Daly et al. in view of U.S. Patent No. 6,029,141 to Bezos et al.

Regarding Claims 1, 20 and 39, Daly discloses a system, method and computer program product for enabling television-based (Col. 6, Lines 39-44) commerce (Col. 7,

Lines 1-3) for generating revenue streams for TV originators. The product is a software program (Col. 7, Lines 40-42) that is readable by a computer system (Col. 6, Lines 37-55) in an interactive television environment (Col. 9, Lines 8-10) connected to a computer network (Col. 6, Lines 56-59). This reads on a computer readable media readable by one or more computer systems. Daly further discloses computer-readable program code means for a consumer initiating a purchase via the TV commerce system (Col. 7, Lines 1-47) using the interactive television environment (See Figure 5) wherein the transaction pertains to an offering of a merchant (Col. 5, Lines 49-60). Daly teaches that a purchase request message includes the identity of a merchant, the identity of a purchaser, and the purchase amount (Col. 7, Lines 1-5). This information reads on the claimed gathering TV context information related to the transaction. The context information is transmitted from the user's set top to the head end and subsequently to a financial institution where the purchaser's credit is checked to verify the purchase amount is within their spending limit (Col. 13, Lines 22-35). This reads on the claimed code means for transmitting TV context information from a device used by the consumer (set top terminal 46) to an issuer of an account of said consumer (financial institution) when requesting authorization of payment, using the account, for the transaction. Further, if the purchase survives the credit test, the user is operable to complete the transaction (Col. 13, Lines 35-45). It is inherent that there must be a message back to the head end from the sponsoring institution informing the transaction processor that the credit check was good or bad and a means of identifying the transaction information (user, amount). This reads on the claimed sending an authorization token to an acquirer (head end transaction processor) if

the issuer (financial institution) authorizes the payment. As a result, the transaction routing system (76) authorizes the withdrawal of funds from the subscriber and credits the merchant (Cols. 13-14, Lines 66-3). This reads on the claimed sending the authorization token to an acquirer that processes payments (transaction routing system) for the merchant when requesting the acquirer to collect the payment for the transaction, and code for concluding that the payment was authorized by the issuer.

Further, Daly teaches digitally signing communications between the set top box and the head end server (Col. 14, Lines 11-25) but not that the communication path between the head end and the financial institution is secure. Daly recognizes the importance of transmitting sensitive financial information using a digital signature. Therefore, while not explicitly recited by Daly, it would have been obvious to use the same digital signature-based protection for data sent between the head end server and the financial institution in order to protect the sensitive information contained therein from being viewed or altered by unauthorized users. This reads on the claimed digitally signing the authorization token by the issuer and verifying the issuer's digital signature to make sure that the TV context information has not been altered.

What is not disclosed, however, is automatically allocating a portion of the payment to one or more of the TV originators according to the TV context information and reducing the amount of the payment to be paid to the merchant by the automatically allocated portion. Bezos discloses computer-readable networked-based commerce software where additional context information is gathered and included in a message corresponding to a transaction (Col. 7, Lines 20-45). Further, Bezos discloses including

the gathered context information in a message (Col. 12, Lines 57-65) corresponding to the transaction. Bezos discloses sending the message to a payment processor that processes payments for the merchant (See Figures 1 and 2) to initiate the consumer's payment to the merchant (See Figure 9). Bezos also discloses automatically allocating a portion of the payment to the originator through the use of the included context information (Col. 13, Lines 1-4). The payment to the merchant is reduced by the amount allocated to the purchase originator. Bezos is evidence that ordinary workers in the art would recognize the benefit of collecting and transmitting context information for billing and commission purposes in an electronic commerce system. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the computer program product for enabling TV-based commerce of Daly with the embedded context information of Bezos in order to increase merchant exposure by compensating TV originators for enabling advertising and subsequent purchase of products.

Regarding Claims 7, 26 and 45, Daly in view of Bezos discloses a system as stated above in Claims 1, 20 and 39. Bezos further discloses a system wherein the program uses the included context information for extracting the identification of the content originators (Col. 12, Lines 52-63) and determining a portion to be allocated using a predetermined percentage (Col. 13, Lines 1-4) of the payment for each of the content originators for whom the identification is extracted.

Regarding Claims 8, 27 and 46, Daly in view of Bezos discloses a system as stated above in Claims 1, 20 and 39. Bezos further discloses a system wherein the

included context information is sent to the content originators (Col. 16, Lines 11-19 and Appendix B) from the payment processor. It is inherent that this data must be extracted from the authorization token in order to be used. As stated above, the acquirer verifies the issuer created the authorization token. Additionally, the content originator receiving the vendor's funds will receive among other things, the name and account information of the purchaser, which are elements of the context information. This information will be sent to the content originators in the form of a statement or payment notification.

Regarding Claim 59, Daly in view of Bezos disclose a method as stated above in Claim 46. It is inherent in such a system that the merchant receives the included context information from the payment processor in order to process the purchase for shipping and record keeping.

Regarding Claim 64, Daly in view of Bezos disclose a method as stated above in Claim 39. As stated above, the gathered TV context information comprises an identification of the consumer.

Regarding Claim 69, Daly in view of Bezos disclose a method as stated above in Claim 39. Daly discloses a product purchase request message that contains the gathered TV context information as stated above. This context information in a purchase request message reads on the claimed indication that the transaction was initiated from the interactive television environment.

Regarding Claim 70, Daly in view of Bezos disclose a method as stated above in Claim 49. Daly further discloses that the user's terminal digital signs transmissions (Col. 8, Lines 47-61) using a public-key encryption (Col. 16, Lines 1-32). It is inherent in such

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a system that the transmitter's digital signature must be verified in order to properly decrypt the encrypted data. This reads on the claimed device digitally signing the payment message on behalf of the consumer before transmission to the issuer and that the issuer verifies the signature as a condition of authorization the payment.

Regarding Claim 71, see Claim 1 above.

5. Claims 62-63 and 65-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daly et al. in view of Bezos et al. and further in view of U.S. Patent No. 6,282,713 to Kitsukawa et al.

Regarding Claim 62, Daly in view of Bezos disclose a method as stated above in Claim 39. What is not disclosed, however, is that the gathered TV context information comprises information from a data stream transmitted with a TV program. Kitsukawa discloses a system for on-demand advertising wherein advertising information is received with broadcasts of television programs (Col. 6, Lines 40-48) for items in scenes of television programming and television commercials. The advertising information includes product information and cost (Col. 8, Lines 46-49). This reads on the claimed gathered TV context information comprising information from a data stream transmitted with a TV program. Kitsukawa is evidence that ordinary workers in the art would recognize the benefits of embedding advertising information within television programming. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Daly in view of Bezos with the embedded advertising information of Kitsukawa in order to effectively transport

the digital data using a well-known transmission protocol such as MPEG as disclosed by Kitsukawa (Col. 5, Lines 29-37).

Regarding Claim 63, Daly in view of Bezos disclose a method as stated above in Claim 39. Further, Daly in view of Bezos and further in view of Kitsukawa further discloses that the TV context information comprises information from an advertisement (television commercial) as stated above in Claim 62. As is well known in the art, television commercials may be shown during a television program.

Regarding Claims 65-67, Daly in view of Bezos disclose a method as stated above in Claim 39. Further, Daly in view of Bezos and further in view of Kitsukawa further disclose a method as stated above in Claim 62. Kitsukawa further discloses that in addition to on-demand advertising information, electronic coupon information may be received and used with television programming and television commercials (Col. 10, Lines 37-47) and redeemed when the user makes a purchase (Col. 12, Lines 1-7). These coupons are further forms of advertising shown during television programming that effect a television commerce transaction. Further disclosed is that data corresponding to the television program associated with the coupon advertising is recorded, including program title, date of airing, time of airing, and channel (Col. 11, Lines 48-54). This information may be sent in a message to a collection center for statistical purposes (Col. 12, Lines 13-15). This reads on the claimed TV context information comprising identification of a TV program and channel as well as the original broadcast data/time of the TV program being watched by the consumer when the transaction was initiated. This information further reads on the claimed TV viewing records of the consumer.

Regarding Claim 68, Daly in view of Bezos and further in view of Kitsukawa disclose a method as stated above in Claim 66. It is inherent that when a user makes a purchase request for an item displayed in a television program or television commercial, that and identification of the item must be transmitted in order for the purchase processor to complete the transaction for the correct item. Because in the method of Kitsukawa, the item being purchased is the same as the item being advertised, this reads on the claimed TV context information comprising an identification of an advertisement (item being displayed and subsequently purchased) from which the consumer initiated the transaction.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. U.S. Patent No. 5,404,393 to Remillard discloses a television-based electronic shopping system (See Figure 4) wherein TV context information is logged by station and time (Col. 6, Lines 1-21).

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew R Demicco whose telephone number is (703) 305-8155. The examiner can normally be reached on Mon-Fri, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MRD

mrd

December 20, 2004


CHRIS GRANT
PRIMARY EXAMINER